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EXAMINER

TRUONG, THANHNGA B

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 07/02/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/392,564

Applicant(s)

TAKAHASHI ET AL.

Examiner

Thanhnga Truong

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4,6-11 and 13-15 is/are allowed.
- 6) ☒ Claim(s) 3,5 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 5 is objected to because of the following informalities: the term "a watermark detection" (on line 14 of page 5) should be changed to "an electronic watermark detection" for the consistency as set forth in all the claims. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. *Referring to claim 12:*

(1) This claim recites the new added limitation: "at least one of: a reader to read information recorded in storage and supply the same to the decoding apparatus (lines 11-12 of page 10). This limitation fails to disclose in the decoding apparatus within the specification and as well as in the Figures 5-6 and 9-10 of the decoding apparatus.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 3 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kori (US 6,480,607).

a. Referring to claim 3:

i. Kori teaches:

(1) A decoding apparatus [i.e., **Figure 4**; the data processing device 30 includes a first CSS decoder 31, a second CSS decoder 32, an MPEG decoder 33, a media type decoder 34, a watermark (WM) detection/re-encoding unit 35, an output controller 36 and switches 37, 38 (column 9, lines 24-28)],

(a) a decryption designation input means for indicating a necessity of decryption of encrypted data in accordance with if an input code data is encrypted or not [i.e., referring to **Figure 4**, the first CSS decoder 31, that is “for indicating a necessity of decryption of encrypted data in accordance with if an input code data is encrypted or not”, performs decryption in accordance with the algorithm matched to the first CSS encoder 21 or using the matched encryption key (column 11, line 12-14)], comprising:

(b) a decryption means for restoring an original video or audio information which is coded by decrypting the input code data which is encrypted [i.e., **decrypting means for doing decrypting matched to encrypting of the playback control data received by the reception means (column 5, line 55-58)**];

(c) a selecting means for switching between an output of said decryption means and an output without using said decryption means [i.e., referring to **Figure 4**, the data processing device 30 includes a first CSS decoder 31, a second CSS decoder 32, an MPEG decoder 33, a media type decoder 34, a watermark (WM) detection/re-encoding unit 35, an output controller 36 and switches 37, 38, that is “a selecting” (column 9, lines 24-28)];

(d) a decoding means for decoding the coded video or audio information, which is outputted from said selecting means [i.e., referring to **Figure 4**, the data processing device 30 includes a first CSS decoder 31, that is “a decoding”, a second CSS decoder 32, that is “a decoding”, an MPEG decoder

**33, a media type decoder 34, a watermark (WM) detection/re-encoding unit 35, an output controller 36 and switches 37, 38 (column 9, lines 24-28)];;**

(e) an electronic watermark detection means for detecting a watermark information indicative of a copy management information, including at least copy prohibition which is superimposed onto the video or audio information [i.e., **the watermark detection/re-encoding unit, that is “an electronic watermark detection”, detects the copyright control information superimposed on the picture data by watermark processing. The detected copyright control information specifies one of “copy free”, “one copy”, “no more copy”, or “never copy”. The watermark detection/re-encoding unit sends the detected copyright control information to the output controller (column 9, line 66-67 and column 10, line 1-6)]; and**

(f) a reproduction restricting means for controlling reproduction of the video or audio information in accordance with said copy management information, when any of the copy management information is detected upon a detection result by said electronic watermark detection means, in case of decoding the coded video or audio information which is inputted, directly without using said decryption means [i.e., **if the watermark detection/re-encoding unit detects the copyright control information other than “one copy”, the reproduction device, that is for “controlling reproduction of the video or audio information in accordance with said copy management information”, outputs the detected copyright control information to outside via switch without doing re-encoding (column 10, line 12-17)].**

b. Referring to claim 12:

i. This claim has limitations that is similar to those of claim 3, thus it is rejected with the same rationale applied against claim 3 above, and,

(1) at least one of: a reader to read information recorded in storage and supply the same to the decoding apparatus [i.e., **as shown in Figure 1, This optical disc reproducing device 100 includes an optical disc drive 101, a data processing device 102 for doing data processing on picture data etc read out**

from the optical disc drive 101 (column 1, lines 48-54). From this optical disc D, the above media type information as well as the compressed picture or audio data is read out by the optical disc drive 101 (column 2, lines 17-19). Furthermore, referring to Figure 4, The optical disc reproducing device 1 of Kori's invention is made up of an optical disc drive 20 for reading out picture data or speech data recorded on the optical disc D, a data processing device 30 for doing data processing on the picture data etc read out from the optical disc drive 20 (column 8, lines 28-34)]; and

(2) an output unit to receive an output of the reproduction apparatus to produce at least one of audio sound and video display [i.e., referring to Figures 4 and 5, the watermark (WM) detection/re-encoding unit 35 sends the detected copyright control information to the output controller 36, that functions like "an output unit". If, as a result of the detection of the copyright control information the watermark (WM) detection/re-encoding unit 35 detects "one copy", it re-encodes the copyright control information superimposed on the picture data, using watermark processing, for changing "one copy" to "no more copy", to output the re-encoded copyright control information to outside via switch 38. If, as a result of the detection of the copyright control information the watermark (WM) detection/re-encoding unit 35 detects the copyright control information other than "one copy", it outputs the detected copyright control information to outside via switch 38 without doing re-encoding. In addition, The output controller 36 performs on/off control of the switches 37, 38 based on the information sent from the media type decoder 34 and from the watermark (WM) detection/re-encoding unit 35 (column 10, lines 4-21)].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kori as applied to claim 3 above, and further in view of Traw (US 5,949,877).

a. Referring to claim 5:

i. Kori teaches the claimed subject matter per claim 3 above except for:

(1) AKE (Authentication and Key Exchange) means for conducting an authentication between a supply device of the input code data and key exchange necessary for decryption.

ii. However, Traw teaches:

(1) AKE (Authentication and Key Exchange) Subsystem is responsible for implementing the protocols which are used to ensure that devices exchanging protected content are compliant (**column 9, line 30-40**).

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) include such AKE subsystem (in Kori) to further detect and protect digital content from violating the copyright protection and/or other misuse during the transferring between devices in accordance with the decryption system (**see Traw's abstract**).

iv. The ordinary skilled person would have been motivated to:

(1) add this AKE circuit in accordance with the decryption system (such as Kori's Data Processing Device - Figure 4, 5, 6, and 7) for safeguarding against unauthorized duplication (**column 1, line 15 of Kori**).

***Allowable Subject Matter***

8. Claims 1-2, 4, 6-11, 13-15 are allowed.

9. The following is an examiner's statement of reasons for allowance: The prior art of record neither anticipates nor renders obvious the instant combination for detecting an electronic watermark information indicative of a copy management information, including at least a copy prohibition which is superimposed onto the video

or audio information, in case where the video or audio information recorded in said storage medium is detected in said encryption system detection means as being not encrypted in accordance with the predetermined encryption system as set forth in each independent claims 1, 6, and 10.

**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Ogino (US 6,577,810 B1) discloses a read-out unit 14, which generates a reproduced video signal S16 (see Figure 1 and column 2, lines 12-13).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 703-305-0327.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax and phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*Handwritten signature*  
AU 2135

TBT

June 24, 2004